

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed November 17, 2005. Claims 1-41 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-41. The present Response amends claims 1, 9, 19, 23, 27, and 35, leaving for the Examiner's present consideration claims 1-41. Reconsideration of the rejections is respectfully requested.

I. Affidavit

1. The affidavit filed on 8/2/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Cannell reference.

2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Cannell reference to either a constructive reduction to practice or an actual reduction to practice. Exhibit 1 does not disclose diligence of the inventions in claims 1-8, 9-18, 19-22, 23-26, 27-34, and 35-41. There is no evidence of data results and testing of the proposal in Exhibit 1.

Exhibit 1 clearly demonstrates reasonable diligence directed to the reduction to practice of the invention at issue as required by MPEP 2138.06. One of ordinary skill in the art would be able to enable the invention based on the embodiments of the invention disclosed in Exhibit 1.

3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Cannell reference. Exhibit 1 fails to disclose conception relating to the invention in claims 19-22, wherein a scanning device is coupled with the processing device.

The evidence is used to swear behind the effective date of the Cannell reference. Since Cannell does not disclose a scanning device coupled with the processing device, whether the evidence discloses a scanning device coupled with the processing device or not is thus irrelevant to the effectiveness of the affidavit.

4. The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Cannell reference. Exhibit 1 fails to disclose an actual reduction to practice of the inventions in claims 1-8, 9-18, 19-22, 23-26, 27-34, and 35-41. There is no evidence of the invention successfully used in the telecommunications industry and data results provided of the invention. Also, page 14 of Exhibit 1

discloses in lines 4-5, '...There is still a need to conduct user-centered design for creating specific interfaces for the scenarios described here...' which is evidence that there is still need for improvement of the proposal disclosed in Exhibit 1. Further, Exhibit 1 fails to disclose an actual reduction to practice of the invention in claims 19-22, wherein a scanning device is coupled with the processing device.

Exhibit 1 meets the requirement in MPEP 2138.05 that it has been actually reduced to practice, and it clearly indicates that the invention is at the stage of "licensing in different telecommunication market segments". U.S. patent law never requires that an invention has to be "successfully used in the telecommunications industry", or there is no longer any "need for improvement" to be eligible as a patentable subject matter and/or actually reduced to practice. In addition, a scanning device coupled with the processing device is irrelevant to the effectiveness of the affidavit to swear behind Cannell as discussed above.

5. Accordingly, the Non-Final rejection filed on 4-7-2005 has not been overcome and is still maintained (Cannell is still considered prior art). That rejection has not been included below. Additionally, the Examiner has provided multiple backup rejections to further reject this application. Please see all rejections below.

Even if Cannell is still considered a prior art, the Examiner stated in the Office Action on April 7, 2005 that "Cannell does not disclose a method comprising: initiating a new communication, which is not necessarily responding to an incoming communication" (Page 4, second paragraph). Thus, Cannell cannot anticipate the present invention in independent claims 1, 9, 19, 23, 27, and 35, which claim such a method. The new prior art of Rosenthal cannot anticipate such method either as discussed later and all discussions related to Rosenthal in the following sections also apply to Cannell.

II. Claim Rejections – 35 USC §112

Claims 1, 9, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9, and 27 has been amended to clearly indicate that a new communication is not in response to an incoming communication, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.

III. Claim Rejections – 35 USC § 102

Claims 1, 3, 8, 27, 28, 30, 32, 34-38 and 40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,764,748 by Rosenthal et al.

Rosenthal teaches an advanced call waiting process, which allows a called party on a first communication to choose how to respond to a second incoming call. In contrast, the present invention is distinguishable from call waiting by allowing a party to initiate communication to a second party while communicating to a first party, even when there is no incoming call received. Therefore, Rosenthal cannot anticipate the present invention in independent claims 1, 27, and 35. Since claims 3 and 8 depend on claim 1, claims 28, 30, 32, and 34 depend on claim 27, claims 36-38 and 40 depend on claim 35, claims 1, 3, 8, 27, 28, 30, 32, 34-38 and 40 cannot be rendered obvious by Rosenthal under 35 U.S.C. 102(b) for at least this reason, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.

IV. Claim Rejections – 35 USC § 103

1. Claims 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal, in view of U.S. Patent No. 6,366,578 by Johnson.

Johnson teaches voice/data communication using a hardware solution that includes "computing system having a multi-bus structure" (Abstract), and it is intended for office attendant type of user who will only initiate a second communication upon receiving an incoming first call. In contrast, the present invention does not need the multi structure required in Johnson, and any user of the invention can initiate a second communication not in response to an incoming call. As discussed earlier, Rosenthal cannot anticipate the initiation of a second communication not in response to an incoming communication either. Therefore, Rosenthal in view of Johnson cannot anticipate the present invention in independent claim 1. Since claim 2, and 4-7 depend on claim 1, claims 2 and 4-7 cannot be rendered obvious by Rosenthal in view of Johnson under 103 (a) for at least this reason, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.

2. Claims 9-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Rosenthal.

Neither Johnson nor Rosenthal can anticipate the present invention of initiating "a first control signal and a second control signal not in response to an incoming communication" in claim 9 as discussed above. Since claims 10-12, and 14-18 depend on independent claim 9, claims 9-12 and 14-18 cannot be rendered obvious over Johnson in view of Rosenthal under 103 (a) for at least this reason, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.

3. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,941,342 by Nelson in view of Rosenthal.

Nelson teaches generating conversation over mobile device without speaking, however, it does not teach initiating "to provide an audible utterance only over the channel associated with said second code not in response to an incoming communication" as claimed in claim 19. Rosenthal cannot anticipate initiating a second communication not in response to an incoming communication either as discussed earlier. Therefore, Nelson in view of Rosenthal cannot anticipate the present invention in claim 19. Since claims 20-22 depend on claim 19, claims 19-22 cannot be rendered obvious over Nelson in view of Rosenthal under 103 (a) for at least this reason, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.

4. Claims 19-22 provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 09/658,243 which has a common assignee and at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented (Note: the application issued as U.S. Patent No. 7,013,279 on March 14, 2006). This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

A Terminal Disclaimer in compliance with 37 CFR 1.321(c) is filed herewith to overcome the provisional rejection over claims 19-22, and Applicant respectfully requests that the rejection with respect to these claims be withdrawn.

5. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being obvious over Rosenthal in view of U.S. Patent No. 6,766,007 by Dermuler et al, hereinafter Dermuler.

Dermuler teaches using additional subject object during communication between two parties, it does not disclose communication over multiple channel as the present invention in claim 19. Rosenthal

cannot anticipate initiating a second communication while continuing with a first communication as discussed earlier. Therefore, Rosenthal in view of Dermuler cannot anticipate the present invention in claim 19. Since claims 20-22 depend on claim 19, claims 19-22 cannot be rendered obvious over Rosenthal in view of Dermuler under 103 (a) for at least this reason, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.

6. Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Rosenthal.

Claim 23 "activates a channel responsive to the first control signal ... not in response to an incoming communication while communicating over another channel concurrently", which neither Johnson nor Rosenthal teaches as discussed above. Since claims 24-26 depend on claim 23, claims 23-26 cannot be rendered obvious over Johnson in view of Rosenthal under 103 (a) for at least this reason, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.

7. Claims 29, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal in view of Johnson.

As discussed above, neither Rosenthal nor Johnson teaches "selecting a phrase representation not in response to an incoming communication" as in independent claim 27. Since claims 29, 31, and 33 depend on claim 27, claims 29, 31, and 33 cannot be rendered obvious over Rosenthal in view of Johnson under 103 (a) for at least this reason, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.

8. Claims 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal, as applied to claim 35 above, in view of Johnson.

As discussed above, neither Rosenthal nor Johnson teaches "generating an audible utterance ... not in response to an incoming communication" as in independent claim 35. Since claims 39 and 41 depend on claim 35, claims 39 and 41 cannot be rendered obvious over Rosenthal in view of Johnson under 103 (a) for at least this reason, and Applicants respectfully request that the rejection with respect to these claims be withdrawn.


V. Conclusion

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 4/17/06

By: 
David T. Xue
Reg. No. 54,554

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Customer No. 23910

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.